

Serial No.: 10/007,496  
Page 5 of 10

### REMARKS

Entry of the foregoing amendments is respectfully requested. Claims 15 and 21 have been amended. New claims 23-28 have been added. Claims 13 and 15-28 are currently pending in the application. Favorable reconsideration of allowance of this application is respectfully requested in light of the foregoing amendments and remarks.

#### 1. Claim Objections

In the Office Action the Examiner has objected to claims 15-21 due to informalities found by the Examiner in these claims.

Applicant respectfully traverses the Examiner's objections to claims 15-21. More specifically, with this Response, Applicant has amended claim 15 to depend from claim 13, and has corrected the spelling error in claim 21 as specifically pointed out by the Examiner. As a result, Applicant respectfully requests that the Examiner withdraw the objections to claims 15-21.

#### 2. Rejections Based on the Prior Art

a) Rejection of claims 13 and 15-22 in light of Morrison et al. (U.S. Patent No. 6,433,068)

In the Office Action, the Examiner has rejected claims 13 and 15-22 under 35 U.S.C. § 102(e) as being anticipated by Morrison et al. (U.S. Patent No. 6,433,068) (the '068 patent).

Applicant respectfully traverses the Examiner rejections to claims 13 and 15-22 based on the '068 patent. More specifically, in each of independent claims 13 and 21, the claimed product includes: 1) a petroleum distillate; and 2) a thixotropic thickener including a triblock copolymer and a hydrocarbon oil. This is confirmed by the Examiner's discussion of the material limitations in Applicant's claims as found in the Office Action. However, in this discussion, the Examiner goes on to state that the hydrocarbon oil also meets the limitation of a petroleum distillate, which is incorrect, in Applicant's opinion. Applicant's reasoning for this is that the

{00084587.DOC /}

Serial No.: 10/007,496

Page 6 of 10

components of the product are the petroleum distillate and the thixotropic thickener, wherein the thickener includes a hydrocarbon oil as a separate component from the petroleum distillate. In Applicant's opinion, the Examiner equates a combination of components having a specific purpose as a thixotropic thickener with the component parts of the thickener when mixed with the petroleum distillate to form the claims product. The recitation of the thixotropic thickener as a limitation in the claims requires that the triblock copolymer and the hydrocarbon oil be combined in a particular way to form the thickener, which is then combined with the petroleum distillate to form the claimed product. The mere addition of the components of the thickener to the distillate does not provide the required thickener, but only an admixture of the components. Therefor, the claiming of the hydrocarbon oil and the triblock copolymer as components of a thixotropic thickener requires that a prior art reference disclose or suggest a thickener having these components that is used in conjunction with the petroleum distillate, and not simply a composition including the constituents of the thickener and a petroleum distillate.

In contrast, the '068 patent discloses a hydrocarbon gel that includes a hydrocarbon, a triblock copolymer, and one or more solids and/or non-hydrocarbon liquids suspended or dispersed therein. Thus, the '068 discloses a composition including only a single hydrocarbon component (the petroleum distillate) in conjunction with the triblock copolymer and the solids, and not a thickener formed of a second hydrocarbon component and the triblock copolymer required by each of the independent claims of the present application. As a result, Applicant believes that the subject matter of claims 13 and 21, as well as claims 15-20 that depend from claim 13, and claim 22 which depends from claim 21, is neither shown nor described by the '068 patent. As such, Applicant believes that claims 13 and 15-22 are allowable in light of the '068 patent and respectfully requests that the Examiner withdraw the rejections to claims 13 and 15-22.

- b) Rejection of claims 13 and 15-22 in light of Graveske (U.S. Patent No. 6,350,810)

Serial No.: 10/007,496  
Page 7 of 10

In the Office Action, the Examiner has also rejected claims 13 and 15-22 under 35 U.S.C. § 102(e) as being anticipated by Graveske (U.S. Patent No. 6,350,810) (the '810 patent).

Applicant respectfully traverses the Examiner's rejection of claims 13 and 15-22 based on the '810 patent. More specifically, as stated previously, each of claims 13 and 21 call for a non-aqueous petroleum distillate product including a petroleum distillate and a thixotropic thickener formed from a triblock copolymer and a hydrocarbon oil. Thus, product includes two separate hydrocarbon components, one that is present in the thixotropic thickener composition and the petroleum distillate that is mixed with the thickener to form the non-aqueous distillate product.

In contrast, the '810 discloses a waterproofing composition that includes an organic solvent, a styrene polymer, which can be a triblock copolymer, and a hydrocarbon resin. The hydrocarbon resin as described in the '810 patent is low molecular weight polymers (oligomers) produced by by-product hydrocarbon, petroleum, or coal tar streams. A hydrocarbon resin is, in effect, a tackifying material as supported by the disclosure of the '810 patent in column 4, lines 21-23 where the '810 patent states the hydrocarbon resin enhances the adhesive and elongation properties of the composition and resulting film.

Thus, hydrocarbon resins are, in effect, compositions which function oppositely to hydrocarbon oils, which are, in essence, lubricants that reduce the adherence of the material to a surface. Therefore, in Applicant's opinion, the '810 patent, while disclosing a composition including an organic solvent, which can be considered to be a petroleum distillate, and a triblock copolymer, does not disclose a thixotropic thickener formed of both a triblock copolymer and a hydrocarbon oil, as required by claims 13 and 21.

For this reason, Applicant believes that independent claims 13 and 21, as well as claims 15-20 and 22, which depend from independent claims 13 and 21, respectively, are not shown or described by the '810 patent. Therefore, Applicant believes that claims 13 and 15-22 are

Serial No.: 10/007,496

Page 8 of 10

allowable and respectfully request that the Examiner withdraw further rejections to claims 13 and 15-22 based on the '810 patent.

### 3. Double Patenting Rejections

In the Office Action, the Examiner has also rejected claims 13 and 15-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '068 patent.

Applicant respectfully traverses the Examiner's rejections of claims 13 and 15-22 under the doctrine of obviousness-type double patenting in light of the '068 patent. More specifically, claim 1 of the '068 patent requires a gel composition including a hydrocarbon as an organic solvent, a polymeric gel component which can be a triblock copolymer, and a suspended or dispersed component formed of at least one hydrocarbon-insoluble solid.

In contrast, the independent claims 13 and 21 of the present application do not include any limitations to a solid similar to claim 1 of the '068 patent. Therefore, because this material limitation is omitted from the claims of the present application, the '068 patent and the present application are claiming compositions that are readily patentably distinct from one another as not every material limitation is required in claim 1 of the '068 patent. Further, these application claims require a thixotropic thickener formed of a triblock copolymer and a hydrocarbon oil that is separate from the petroleum distillate as discussed previously. Thus, the claims of the present application require a thixotropic thickener formed of a triblock copolymer and a hydrocarbon oil that is added to the petroleum distillate, which is a limitation not found in claim 1 of the '068 patent.

As a result, Applicant believes that claims 13 and 15-22 cover a product that is clearly patentably distinct from claim 1 of the '068 patent, and respectfully requests that the Examiner withdraw the rejections to claims 13 and 15-22.

{00084587.DOC /}

Serial No.: 10/007,496

Page 9 of 10

**4. New Claims 23-28**

With this response, Applicant has also added new claims 23-28. Claims 23-25 depend from previously presented claim 21 and, therefore, include all of the limitations of claim 21. Because claim 21 is considered to be allowable by the Applicant for the reasons stated previously, claims 23-25 are also believed to be allowable.

New claim 26, and claims 27-28 that depend from claim 26, covers a petroleum distillate product formed by a process of providing a petroleum distillate and adding a thixotropic thickener to the distillate, wherein the thickener is formed from a hydrocarbon oil and a triblock copolymer. Claims 26 is also believed to be allowable by Applicant as claim 26 clearly states that the product covered by claim 26 is formed in a specified manner of two separate components, namely, the petroleum distillate and the thixotropic thickener. In addition, the claim requires that the thixotropic thickener be comprised of both a triblock copolymer and a hydrocarbon oil which is separate from the distillate product.

For these reasons, Applicant also believes that claims 23-28 newly added to the application with this Response are allowable.

**CONCLUSION**

It is submitted that claims 13 and 15-28 are in compliance with 35 U.S.C. §102 and define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

No fees are believed to be payable with this communication. However, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the director is authorized to charge any fee or credit any overpayment to Deposit Account No. 50-1170.

Serial No.: 10/007,496

Page 10 of 10

The Examiner is invited to contact the undersigned by telephone if it would help expedite the prosecution and allowance of this application.

Respectively submitted,



Mathew E. Corr  
Registration No. 45,434  
[mec@boylefred.com](mailto:mec@boylefred.com)

Dated: October 13, 2005

**Customer Account No.: 23598**

Boyle, Fredrickson, Newholm,  
Stein & Gratz, S.C.  
250 Plaza Building, Suite 1030  
250 East Wisconsin Avenue  
Milwaukee, WI 53202  
Telephone: (414) 225-9755  
Facsimile: (414) 225-9753

{00084587.DOC /}

PAGE 10/10 \* RCVD AT 10/13/2005 3:37:58 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-6/28 \* DNI:2738300 \* CSID:4142259753 \* DURATION (mm:ss):03-10

**BEST AVAILABLE COPY**